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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,875	12/14/2001	Douglas B. Quine	F-438	7735

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EXAMINER

WALSH, JOHN B

ART UNIT PAPER NUMBER

2151

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/016,875	Applicant(s) QUINE ET AL.	
	Examiner John B. Walsh	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form-PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/11/02 & 11/25/02</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation “the records being different than the identifier portion”. It is unclear how and to what degree the records are “different” than the identifier portion.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 2, 7, 9, 10 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The recited steps of the method are something that can be done by a person as a mental step or using pencil and paper. A person could ask someone to review the e-mail address, wherein they would identify portions of the email, compare it to a record, which may be an address book, and

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indicate to the sender of the message what they find and may make suggested address corrections. Furthermore, the method does not require the use of hardware to accomplish the steps and is not tangible.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-9 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,839,738. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent discloses identifying, comparing, parsing and sending a suggested correction for the incorrect/undeliverable message address.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. As best understood, claims 1, 4, 7 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,427,164 to Reilly.

As concerns claim 1, a method for directing an undeliverable e-mail message to a correct recipient, the e-mail message having an email address, the method comprising: identifying a domain in the e-mail address (column 10, lines 20-24); identifying an identifier portion of the e-mail address (column 10, lines 20-24); comparing (column 10, lines 20-24) the identifier portion to records for predetermined e-mail recipients associated with the domain to determine whether the identifier portion is consistent with the record of any of the predetermined e-mail recipients, the records being different than the identifier portion (column 10, line 24); and if the identifier portion is consistent with the record for a first e-mail recipient associated with the domain, indicating to a sender of the e-mail message that the first e-mail recipient has been found (if identifier is consistent then the address is correct and will be sent, wherein the sender will receive indication that the recipient has been found by not receiving an "address not found" message).

As concerns claim 4, a method for directing an undeliverable e-mail message to a correct recipient, the e-mail message having an e-mail address, the method comprising: associating a plurality of disfavored e-mail addresses with corresponding forwarding e-mail addresses (column 10, lines 25-29); comparing (column 10, lines 25-29) the e-mail address to the plurality of disfavored e-mail addresses; and if the e-mail address matches one of the plurality of disfavored e-mail addresses, forwarding at least a portion of the e-mail message to a corresponding forwarding

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e-mail address (column 10, lines 30-33); and if the e-mail address does not match one of the plurality of disfavored e-mail addresses, then identifying a domain in the e-mail address (column 10, lines 20-24); identifying an identifier portion of the e-mail address (column 10, lines 20-24); comparing (column 10, lines 20-24) the identifier portion to records for predetermined e mail recipients associated with the domain to determine whether the identifier portion is consistent with the record of any of the predetermined e-mail recipients; and if the identifier portion is consistent with the record for a first email recipient associated with the domain, indicating to a sender of the email message that the first e-mail recipient has been found (if identifier is consistent then the address is correct and will be sent, wherein the sender will receive indication that the recipient has been found by not receiving an "address not found" message).

As concerns claim 7, a method for directing an undeliverable e-mail message to a correct recipient, the e-mail message having an e-mail address, the method comprising: identifying a domain in the e-mail address (column 10, lines 20-24); receiving recipient information regarding the correct recipient to whom the message is intended at the e-mail address, recipient information being other than an identifier portion of the e-mail address (column 10, lines 20-24); comparing (column 10, lines 20-24) the recipient information to a list of predetermined e-mail recipients associated with the domain portion to determine if the recipient information matches any of the predetermined e-mail recipients for the domain; indicating to a sender of the e-mail message that the correct recipient has been identified at the domain (if identifier is consistent then the address is correct and will be sent, wherein the sender will receive indication that the recipient has been found by not receiving an "address not found" message).

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As concerns claim 9, the method of claim 7 wherein the recipient information is the name of the correct recipient (column 3, lines 33-35).

9. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,694,353 to Sommerer.

As concerns claim 1, a method for directing an undeliverable e-mail message to a correct recipient, the e-mail message having an email address, the method comprising: identifying a domain in the e-mail address (identified when received at mail server); identifying an identifier portion of the e-mail address (identified when received at mail server); comparing the identifier portion to records for predetermined e-mail recipients associated with the domain to determine whether the identifier portion is consistent with the record of any of the predetermined e-mail recipients, the records being different than the identifier portion (column 4, lines 30-32); and if the identifier portion is consistent with the record for a first e-mail recipient associated with the domain, indicating to a sender of the e-mail message that the first e-mail recipient has been found (column 4, line 26, will receive indication that the recipient has been found by not receiving an "address not found" message).

As concerns claim 2, performing e-mail address correction on the e-mail address to determine a suggested corrected e-mail address (figure 2); and providing the suggested corrected e-mail address to a sender of the e-mail message (figure 2).

As concerns claim 3, sending a forward confirmation request to the sender of the e-mail message, indicating that the e-mail message will be forwarded to the first e-mail recipient (figure 3, allow user option of setting the other email address as the default address for the contact);

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forwarding the e-mail message to the first e-mail recipient when a forwarding confirmation authorization is received from the sender of the e-mail message (user then sends the message).

As concerns claim 4, a method for directing an undeliverable e-mail message to a correct recipient, the e-mail message having an e-mail address, the method comprising:

associating a plurality of disfavored e-mail addresses with corresponding forwarding e-mail addresses (figure 4, check status of destination email in the database); comparing (figure 4, check status of destination email in the database) the e-mail address to the plurality of disfavored e-mail addresses; and if the e-mail address matches one of the plurality of disfavored e-mail addresses, forwarding (figure 4, check for other email addresses) at least a portion of the e-mail message to a corresponding forwarding e-mail address; and if the e-mail address does not match one of the plurality of disfavored e-mail addresses, then identifying a domain in the e-mail address (identified when received at mail server); identifying an identifier portion of the e-mail address (identified when received at mail server); comparing (compared when received at mail server) the identifier portion to records for predetermined e mail recipients associated with the domain to determine whether the identifier portion is consistent with the record of any of the predetermined e-mail recipients; and if the identifier portion is consistent with the record for a first email recipient associated with the domain, indicating to a sender of the email message that the first e-mail recipient has been found (column 4, line 26, will receive indication that the recipient has been found by not receiving an "address not found" message).

As concerns claims 5 and 11, the method of claim 4 wherein if the e-mail address does not match one of the plurality of disfavored e-mail addresses and if the identifier portion is not consistent with the record for an e-mail recipient, then the method further including: performing e-

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mail address correction on the e-mail address to determine a suggested corrected e-mail address (figure 4, allow user the option of changing destination); and providing the suggested corrected e-mail address to a sender of the e-mail message (figure 2).

As concerns claim 6, the method as recited in claim 4, wherein if the identifier portion is consistent with the record for a first e-mail recipient associated with the domain, further including the steps of: sending a forward confirmation request, indicating that the e-mail message will be forwarded to the first e-mail recipient, to the sender of the e-mail message (figure 3, allow user option of setting the other email address as the default address for the contact); and forwarding the e-mail message to the first e-mail recipient when a forwarding confirmation authorization is received from the sender of the e-mail message (authorized by user sending the message).

As concerns claim 7, a method for directing an undeliverable e-mail message to a correct recipient, the e-mail message having an e-mail address, the method comprising: identifying a domain in the e-mail address; receiving recipient information regarding the correct recipient to whom the message is intended at the e-mail address, recipient information being other than an identifier portion of the e-mail address (identified when received at mail server); comparing the recipient information to a list of predetermined e-mail recipients associated with the domain portion to determine if the recipient information matches any of the predetermined e-mail recipients for the domain (compared at mail server); indicating to a sender of the e-mail message that the correct recipient has been identified at the domain (column 4, line 26; will receive indication that the recipient has been found by not receiving an "address not found" message).

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As concerns claim 8, the method as recited in claim 7 further including the steps of: sending a forward confirmation request, indicating that the e-mail message will be forwarded to the correct recipient, to the sender of the e-mail message (figure 3, allow user option of setting the other email address as the default address for the contact); and forwarding the e-mail message to the correct recipient when a forwarding confirmation authorization is received from the sender of the e-mail message (authorized by user sending the message).

As concerns claim 9, the method of claim 7 wherein the recipient information is the name of the correct recipient (contact information).

As concerns claim 10, the method of claim 7 wherein the step of receiving recipient information includes deriving the recipient information from content of the e-mail message (derived from message tags encoded with the message).

Conclusion

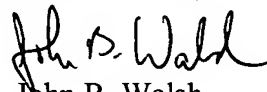
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Friday from 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John B. Walsh
Primary Examiner
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